

ARNOLD & PORTER LLP



Thomas E. Holsten
Thomas_Holsten@aporter.com

202.942.5085
202.942.5999 Fax

555 Twelfth Street, NW
Washington, DC 20004-1206

January 31, 2005

1631
DFW

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Art Unit: 1631
Examiner: M.L. Borin
Conf. No.: 5102

Re: U.S. Patent Application No. 09/696,664 filed October 25, 2000

Inventors: Mark S. ABAD *et al.*

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Atty. Dkt: 16517.316

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Request for Suspension of Appeal; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Appellants do not believe any additional fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.316. A copy of this letter is attached for this purpose.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. E. Holsten".

Thomas E. Holsten (Reg. No. 46,098)

Enclosures

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Mark S. ABAD *et al.*

Appln. No.: 09/696,664

Filed: October 25, 2000

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants



Art Unit: 1631

Examiner: Michael L. Borin

Atty. Dkt. No.: 16517.316

Conf. No.: 5102

Request for Suspension of Appeal

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences (“Board”) suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal Circuit (“Federal Circuit”). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal.¹

On February 13, 2004, Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on April 13, 2004, and a Reply Brief on September 13, 2004. No oral hearing has been requested in this application.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher* (U.S. Appln No. 09/619,643, B.P.A.I. Appeal

¹ Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. See, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.²

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. *See e.g.*, M.P.E.P. §1213, 8th Edition, Revision No. 2, at page 1200-31.

For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,



Thomas E. Holsten (Reg. No. 46,098)
David R. Marsh (Reg. No. 41,408)

Of Counsel:

Of Counsel:

Lawrence M. Lavin, Jr. (Reg. No. 30,768)
Thomas E. Kelley (Reg. No. 29,938)

Correspondence Address:

Monsanto Company
Patent Department E2NA
800 N. Lindbergh Boulevard
St. Louis, Missouri 63167
Tel: 314-694-1000
Fax: 314-694-9009

Arnold & Porter LLP
555 Twelfth Street, N.W.
Washington, DC 20004
Tel: 202-942-5000
Fax: 202-942-5999

² The Board has upheld Examiners' utility rejections in similar appeals. See, e.g. Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.